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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,774	05/27/2004	James J. Wang	25040-1115	3773

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SUTHERLAND ASBILL & BRENNAN LLP  
999 PEACHTREE STREET, N.E.  
ATLANTA, GA 30309

EXAMINER
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ELKINS, GARY E

ART UNIT	PAPER NUMBER
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3782

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/709,774		WANG, JAMES J.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Gary E. Elkins		3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5 IDS statements</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. It is noted that the references line through on the IDS statement submitted 04 August 2005 were previously submitted in other prior art statements and have been initialed on the previously submitted IDS statements.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, “and separated by a top panel fold line” is unclear, i.e. the top panel tab is separated from what?

In claim 1, lines 10-12 are unclear with respect to how both of second score lines are extending from both the first side panel and second side panel to the first fold line, i.e. as disclosed, the pair of second score lines extend respectively from the first side panel and second side panel as opposed to both of the second score lines doing so.

Claim 9 is unclear with respect to how both the first side panel score line and the second side panel score line comprise a “U” shape, i.e. it would appear that each of them do so.

Claim 10 is unclear with respect to how both the first and second corner flaps together comprise a rectangle, i.e. it would appear that each of the form a “U” shape as opposed to both of them together.

In claim 12, it is unclear how both of the side panels tabs comprise a single common finger cut out, i.e. it would appear that each of them do.

In claim 15, it is unclear how each of the corner posts comprises a length along both the first and second side panels, i.e. it would appear that each corner post only extends along one of the first and second side panels.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Bone.

Bone discloses top panel (95, 105, etc), first and second side panels 90, top panel tab 70, a first score line formed by the center tear line and second score lines between removable portions 90 and corner flaps 105 at each corner. The corner portions 105 and the portions of the respective side panels and end panel therebelow are considered to form corner posts insofar as claimed.

5. Claims 1, 3, 13, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mazocky (EP '029). Mazocky discloses a top panel, side panels 4, 5, top panel tab 11, a first score line 17 extending between sides 4, 5 in the near the center of the top wall, second score lines 17 respectively extending at an angle from the side panels to the end panel and corner flaps formed by the angled score lines. With respect to claims 13 and 19, the corner flaps formed in the top wall and the sections of the side walls and end walls therebelow are considered to form corner posts insofar as claimed. With respect to claim 20, it is noted that the top enclosure or

panel, the side enclosures or panels and the end enclosures or panels include multiple score lines (e.g. note sections 3a in the end panel) defining the corner posts insofar as claimed.

6. Claims 1-3, 6, 7, 13 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Quantance. Quantance discloses a top panel 12, 160, side panels 14, 18 along two opposite sides of the carton, an end panel 14, 18 between the side panels, top panel tab 14 at the end of the carton, a first top score line between 12 and 14 at the opposite end of the carton, second top score lines 16 at the first end of the carton forming corner flaps 160 and side panel tabs 18 with side panel score lines 16 formed in the side panels as claimed.

7. Claims 1-7, 9, 13 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Auclair. Auclair discloses a top panel (16, 48, triangular corner sections), two side panels 14, 18, top panel tab 44, first score line 50, second score lines forming the triangular corners within the top panel, side panel tabs 60, 62 attached to the remainder of the side panels along score lines 52, 54 as claimed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bone in view of any one of Stompe, Schmidt et al or Hunt, Jr. Bone discloses all structure of the claimed carton except a finger cut out within the top panel (cl. 11) or the removable portion (cl. 18) (Bone discloses a finger flap formed by the cut 120 which forms a finger opening when pressed

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inwardly). Each of Stompe, Schmidt et al and Hunt, Jr. teaches that it is known to make a finger engagement element as a cut out. It would have been obvious to make the finger engagement element in the top wall in Bone as a cut out as taught by any one of Stompe, Schmidt et al or Hunt, Jr. to allow easier engagement by the finger and to eliminate interference by the folding tab with the contents (when the tab would be pressed inwardly).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auclair in view of Holley, Jr. '435 and any one of Stompe, Schmidt et al or Hunt, Jr. Auclair discloses all structure of the claimed carton except finger cut outs formed in the side panel tabs. Holley, Jr. teaches that it is known to make a removable dispensing portion in a container with side panel finger engagement elements to facilitate removal of the side panel portions from the remainder of the side panels. Each of Stompe, Schmidt et al and Hunt, Jr. teaches that it is known to make finger engagement elements in a container using cut outs as opposed to openings formed by folding tabs. It would have been obvious to make the side panels in Auclair with finger engagement elements as taught by Holley, Jr. and to make the finger engagement elements as cut outs as taught by any one of Stompe, Schmidt et al or Hunt, Jr. to allow clean separation of the side portions of the removable portion during opening and since openings provide less chance of interference by the side flaps with the contents.

11. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quantance. Quantance discloses all structure of the claimed carton except formation of the corner flaps/posts in the form of a rectangle, i.e. the corner flaps in Quantance are formed with a curvilinear inner section 16. It would have been an obvious matter of design choice to change the form or shape of the corner flaps/posts to a rectangular shape in Quantance as a mere

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selection of one shape over any other. No functional distinction is seen between the shape claimed and that shown in the prior art to Quantance nor has any been asserted by Applicant. Design applications are available to obtain patent protection where the sole distinction between the prior art is one of shape or aesthetics. Also, no convincing argument has been made that the particular shape claimed is significant or is more than one of numerous configurations a person of ordinary skill in the art would have found obvious. See *Graham v. John Deere Co.*, 148 USPQ 459 (1967) and *In re Dailey*, 149 USPQ 47 (CCPA 1976).

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Auclair or Bone. Each of Bone and Auclair discloses corner posts with a length along the respective side and end panels which is very small as compared to the overall lengths of the side and end panels. However, each of Bone and Auclair does not disclose a length of the corner post along the respective side panels and the end panel of about 1 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts along the respective side and end panels in each of Bone and Auclair about 1 cm as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in the prior art. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package.

13. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Quantance, Bone, Auclair or Mazocky. The patent to Quantance, Bone, Auclair or Mazocky

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each discloses all structure of the claimed carton except a length of the corner post in the side panels of about 8.3 cm and, with respect to claim 17, a length into the end panel of about 8 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts within the side and end panels of about 8.3 cm and 8 cm, respectively as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in the prior art. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package.

#### ***Allowable Subject Matter***

14. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The remaining cited prior art is illustrative of the general state of the art.

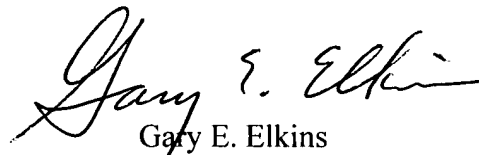
In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (571)273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.



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Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday through Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Nathan Newhouse can be reached at (571)272-4544.

  
Gary E. Elkins  
Primary Examiner  
Art Unit 3727

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06 January 2006